

AMENDMENTS TO THE DRAWINGS WITHOUT MARKINGS

IN THE DRAWING:

Fig. 6 has been added.

REMARKS

The last Office Action of March 17, 2009 has been carefully considered. Reconsideration of the instant application in view of the foregoing amendments and the following remarks is respectfully requested.

Claims 1-11, 16, 17 are pending in the application. Claims 1, 16 have been amended. Claims 2, 17 have been canceled. Claim 21 has been added. Amendments to the specification and drawing have been made. No fee is due.

OBJECTION TO THE DRAWING

The drawings are objected to because of applicant's failure to show a further sewer pipe and a boring device. A new Fig. 6, labeled "NEW SHEET", is submitted herewith and schematically show the arrangement of a second sewer pipe and a boring device.

The specification has been amended to make it consistent with the amendments to the drawing. No new matter has been added.

Withdrawal of the objection to the drawing is thus respectfully requested.

CLAIM REJECTIONS - 35 U.S.C. §101

Claims 1-11 stand rejected under 35 U.S.C. §101, because they improperly embrace both product and process.

The rejection under 35 U.S.C. 101 is respectfully traversed in view of the following remarks.

Claim 1 of file is directed to a sewer pipe which is defined by various structural claim limitations, such as partial pipe shells, first connecting means, and second connecting means, which are interrelated in a manner as set forth in claim 1. The reference in the preamble of claim 1 that the sewer pipe is intended to be drawn into the ground in a horizontal boring method, and in the body of claim 1 that the sewer pipe is

drawn horizontally into the ground are intended to show the environment in which the sewer pipe is used. Claim 1 does not contain specific process steps to define the product per se. The reference to *Ex parte Lyell*, 17 USPQ2d 1549, is therefore inapposite because claim 2 in dispute in that case recited structural limitations and in addition positively recited specific process steps so that the entire claim became ambiguous and impossible to determine the scope. This is not the case here because claim 1 on file does not combine two separate statutory classes of invention in a single claim.

Claim 1 on file is unambiguously a product claim and not divided into different sections that relate to different statutory classes. Claim 1 on file does not set forth a defined series of acts but recites structure that is clearly determinative of the scope of the claim.

Withdrawal of the rejection of the claims 1-11 under 35 U.S.C. §101 is thus respectfully requested.

CLAIM REJECTIONS - 35 U.S.C. §112, SECOND PARAGRAPH

Claims 1-11 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As noted *supra*, the reference to "when the sewer pipe is drawn" merely indicates the environment in which the claimed product is used and does not render claim 1 ambiguous that would make impossible to determine the scope of the claim 1.

The Examiner's rejection is also confusing with respect to the other formal objections. The Examiner appears to misunderstand the use of the so-called "Markush expression" which is used in claim drafting to eliminate the need for alternative language. Thus, the expression in claim 1 of "the sewer pipe is [] attached to an element selected from the group consisting of a further sewer pipe and a boring device" merely states that the sewer pipe can be attached to a further sewer pipe or to a boring device. The reference to "element" in claim 7 thus merely sets forth that the sewer pipe can

have a recess for engagement by an elevation of the element which may be the further sewer pipe or the boring device. Claim 8 set forth the reverse configuration, i.e. the sewer pipe has an elevation for engagement in a recess of the element which may be the further sewer pipe or the boring device.

Likewise claim 16 uses Markush expression to eliminate the presentation of alternative language.

Withdrawal of the rejection of the claims 1-11, 16 under 35 U.S.C. §112, second paragraph is thus respectfully requested.

CLAIM REJECTIONS - 35 U.S.C. §103(a)

Claims 1, 3-4, 6-11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 4,647,256 to Hahn et al. in view of U.S. Pat. No. 4,779,902 to Lee.

Claims 2, 3, 5 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hahn et al. in view of Lee and further in view of either Knox et al., or Sullivan, or Swisher, or Ahn et al., or Petrovic, or Fisher, or Tyrer et al., or Dennehey et al.

Claim 16 stands rejected under 35 U.S.C. §103(a) as being unpatentable over EP document '583 in view of Hahn et al. and Lee.

Claim 17 stands rejected under 35 U.S.C. §103(a) as being unpatentable over EP document '583 in view of Hahn et al. and Lee, and further in view of either Knox et al., or Sullivan, or Swisher, or Ahn et al., or Petrovic, or Fisher, or Tyrer et al., or Dennehey et al.

The rejection under 35 U.S.C. 103(a) is respectfully traversed in view of the amendments to independent claims 1, 16 and the following remarks.

Claim 1 has been amended by incorporating the subject matter of claim 2 and claim 16 has been amended by incorporating the subject matter of claim 17. In other words, the hinged connection of the pipe shells has been set forth in the independent claims 1 and 16. In addition, the reference to "rectangular" has been deleted from claim 1 and is now set forth in newly submitted claim 21.

In rejecting claims 2 and 17, respectively, the Examiner applied the references to Knox et al., or Sullivan, or Swisher, or Ahn et al., or Petrovic, or Fisher, or Tyrer et al., or Dennehey et al., in combination with Hahn and Lee and in combination with EP document '583, Hahn et al. and Lee, to show the disclosure of a hinge.

The present invention, as set forth in claims 1 and 16 is directed to sewer pipes that are used underground and pulled in trenchless laying by horizontal boring heads.

It is applicant's contention that the Examiner failed to make a prima facie case of obviousness and failed to provide any reason or explicit analysis of why the disclosures of the references to Knox et al., or Sullivan, or Swisher, or Ahn et al., or Petrovic, or Fisher, or Tyrer et al., or Dennehey et al., should be combined with Hahn and Lee or with EP document '583, Hahn et al. and Lee. (Ex parte Erkey et al. appeal 20071375, decided May 11, 2007).

The Knox reference is directed to a tamperproof port cover for the port of a container for medical liquids. Likewise, Dennehey describes a protector for a medical device for protecting a connection between a plastic dialysis solution container and a tubing carried by a patient. Sullivan discloses a clamp for securing a hose connection. Swisher discloses a tamper evident sleeve engageable to a catheter. Ahn et al. discloses a wire protecting structure for connecting a wire to an insulator. Petrovic discloses a showerhead security cover to secure the showerhead to a shower arm and thereby prevent unauthorized access to a connector of a shower assembly. Fisher discloses a coupler for a flexible tube used to repair a flexible conduit, such as a catheter. Tyrer et al. discloses a protective ducting for receiving a pipe or cable.

An artisan in the field of sewers would not consider references that are involved with clamps for hoses, catheter, and electric cables because sewer pipes must withstand great forces as they are drawn through the ground. The approach taken by the Examiner to pick and choose among individual portions of various prior art references as a mosaic to recreate a facsimile of the claimed invention is ill-advised.

For the reasons set forth above, it is applicant's contention that the applied prior art fails to teach or suggest the features of the present invention, as recited in claims 1 and 16.

As for the rejection of the retained dependent claims, these claims depend on claim 1, share its presumably allowable features, and therefore it is respectfully submitted that these claims should also be allowed.

Withdrawal of the rejection under 35 U.S.C. §103(a) is thereof respectfully requested.

CONCLUSION

In view of the above presented remarks and amendments, it is respectfully submitted that all claims on file should be considered patentably differentiated over the art and should be allowed.

Reconsideration and allowance of the present application are respectfully requested.

Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully requested that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. If the Examiner feels that it might be helpful in advancing this case by calling the undersigned, applicant would greatly appreciate such a telephone interview.

Respectfully submitted,

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